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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,097	02/24/2004	William P. O'Donnell	45054.00.058	8794

7590 05/06/2005
JOHN W. HARBST
1180 LITCHFIELD LANE
BARTLETT, IL 60103

EXAMINER

LE, MARK T

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,097

Applicant(s)

O'DONNELL ET AL.

Examiner

Mark T. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,6,7,9,10,13-15,17-23,25-30 and 35-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-23,25-30,38,39 and 43-45 is/are allowed.
- 6) ☒ Claim(s) 2,3,6,7,9,10,13-15,35,37 and 40-42 is/are rejected.
- 7) ☐ Claim(s) 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/8/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is responsive to the amendments filed on March 31, 2005. Applicant's amendments and arguments have been carefully considered. The previous favorable indication of certain claims has been withdrawn in view of the new grounds of rejections set forth below. Any inconvenience to Applicant and their representative is regretted.

2. In claim 43, line10, it is believed that the expression "thereto" refers to either the housing assembly or the hollow base. In any event, correction is required to clearly specific the structure being referred to.

3. Claims 7 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7, last three lines, the expression "each wedge-shaped insert being secured to said walled receptacle to inhibit shifting movements of the walled receptacle of said side bearing assembly relative to said bolster" is not clear. This instant claimed structure appears to be inconsistent with the present invention.

In claim 14, last line, "said walled enclosure" lacks antecedent basis.

4. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically note the structure recited in the last three lines of

claim 7 - "each wedge-shaped insert being secured to said walled receptacle to inhibit shifting movements of the walled receptacle of said side bearing assembly relative to said bolster".

5. Claims 6-7, 13-15, 35 and 37 (7 as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Spencer (US 5,086,707).

Spencer discloses a constant contact side bearing assembly having all the features recited in the instant claims, including spring 60, body member/walled housing 56, walled receptacle 20, an apparatus including inserts 80,82 or shims 100, 102, and friction member/cap 54; wherein, said friction member/cap 54 is moveable relative to body member/walled housing 56.

Regarding instant claims 7 and 14, note that inserts 80,82 of Spencer are secured to both body member 56 and walled receptacle 20, and that both said body and receptacle are inhibited in shifting movements, as broadly claimed.

6. Claims 2-3, 9-10 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer (US 5,086,707) in view of Geyer (US 3,707,927).

Spencer is applied above.

Regarding the instant claimed spring being in the form of a deformable block of elastomeric material, as recited in instant claims 2, 9, 40 and 41, note Geyer; wherein, the spring in a constant contact bearing may alternatively be a deformable block of elastomeric material. In view of Geyer, it would have been obvious to one skilled in the art substitute a deformable block of elastomeric material, similar to that taught by Geyer, for the coil spring of Spencer, so as to achieve expected advantages of elastomeric

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springs - such as in terms of lower noises, high durability, less vibrations, lower costs, or greater corrosion resistances.

7. Claims 17-23, 25-30, 38-39 and 43-45 are allowable.

8. Claim 36 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The above descriptions of the applied references are considered to either directly or indirectly address the relevant points of arguments raised by the applicant with respect to the applied references.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Le whose telephone number is 571-272-6682. The examiner can normally be reached on Mon-Fri (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark T. Le
Primary Examiner
Art Unit 3617

mle
5/2/05